

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Ted A. BARNES	§	
	§	
Serial Number: 10/727,697	§	
	§	Group Art Unit: 3727
Filed: December 4, 2003	§	
	§	
For: ACCESSORY MOUNT FOR VEHICLE	§	Examiner: Lester L. Vanterpool
CONTROL BODIES	§	

REPLY IN APPEAL PURSUANT TO 37 CFR § 41.41

Dear Sir,

This Reply Brief is submitted in reply to the Examiner's Answer dated September 3, 2009.

TABLE OF CONTENTS

Statement of Real Party of Interest	3
Related Applications and Interferences	3
Status of the Claims	3
Status of the Amendments	4
Summary of the Claimed Subject Matter	5
Grounds of Rejection to be Reviewed on Reply in the Appeal	7
Arguments in Reply	8
<i>A. The Meaning of the terms Control Body, Control Body Bracket, and Relation to Throttle and Clutch Control Bodies</i>	<i>8</i>
<i>B. Reply to the Examiner's Answer as to whether the preambles to the claims breathe life and meaning into each claim so that the preambles should be accorded full weight in assessing patentability over the cited prior art.....</i>	<i>9</i>
<i>C. The Primary Masui Reference</i>	<i>13</i>
10. <i>Whether Claims 6 and 7 are obvious under 35 USC § 103(a) due to Masui et al. in view of Koskinen.</i>	<i>16</i>
11. <i>Whether Claims 15 and 16 are obvious under 35 USC § 103(a) due to Masui et al. and Japan Patent 4-133886 in view of Koskinen.</i>	<i>18</i>
Secondary Consideration	20
CONCLUSION	21
Claims Appendix	22
Evidence Appendix	26
Related Proceedings Appendix	26

REPLY BRIEF

Statement of Real Party of Interest

37 C.F.R. § 41.37(c)(1)(i)

The real parties of interest in this patent application are the inventor, Ted A. Barnes of 4514 Tranquility Drive, Garland, Texas 75043, and Storm LLP of 901 Main Street, Suite 7100, Dallas, Texas 75202.

Related Applications and Interferences

37 C.F.R. § 41.37(c)(1)(ii)

U.S. Application No. 10/778,385, filed February 13, 2004, is a related application. There are no Interferences in this or the related application.

Status of the Claims

37 C.F.R. § 41.37(c)(1)(iii)

All pending claims stand rejected and Applicant appeals the rejection of each of the rejected claims. All claims were initially rejected in a Final Office Action dated August 12, 2008, and the bases for rejection of Claims 6, 7 and 15, 16 were withdrawn but substituted with new grounds in the Examiner's Answer of September 3, 2009. There are 19 pending claims numbered as Claims 1-19. Claims 1, 7, 8, 15, and 19 are independent claims.

- a. Claims 1, 3 and 5 stand rejected as anticipated under 35 USC § 102(b) by Masui et al. (US Patent 6,305,241).
- b. Claim 2 is rejected under 35 USC § 103(a) as obvious due to Masui et al. in view of Ho (US Patent 6,062,053).
- c. Claim 4 is rejected under 35 USC § 103(a) as obvious due to Masui et al. in view of Chen (US Patent 6,644,614).
- d. Claims 6 and 7 are rejected under 35 USC § 103(a) as obvious due to Masui et al. in view of Koskinen.
- e. Claims 8 - 10, 12, 14, 17, and 19 are rejected under 35 USC § 103(a) as obvious due to Masui et al. in view of Japan Patent 4-133886.

- f. Claim 11 is rejected under 35 USC § 103(a) as obvious due to Masui et al. and Japan Patent 4-133886, further in view of Chen.
- g. Claims 13 and 18 are rejected under 35 USC § 103(a) as obvious due to Masui et al. and Japan Patent 4-133886, further in view of Ho (US Patent 6,062,053).
- h. Claims 15 and 16 are rejected under 35 USC § 103(a) as obvious due to Masui et al. and Komo in view of Koskinen.

Status of the Amendments

37 C.F.R. § 41.37(c)(1)(iv)

No Amendment was filed responsive to the Final Office Action of August 12, 2008. The Final Office Action, now under appeal, rejected Applicant's arguments for patentability presented in the last Amendment, which was filed on June 12, 2008. The Final Office Action took the position that the claim preambles merely recite the intended use of the claimed structures. [See, page 12, third paragraph of the Final Office Action.] The preamble portion being ignored states: "a handle-barred vehicle throttle or clutch control body." Applicant traversed the nullifying of this language and conducted the interview of August 19, 2008, through its counsel to discuss this issue. Applicant also provided copies of case law in support of its position that the preambles of the instant claims breathe life and meaning into the claims and should be accorded weight in assessing patentability in order to encourage favorable reconsideration. However, as explained in more detail in Applicant's Supplemental Interview Summary paper filed on November 6, 2008, no agreement was reached. As a consequence, an appeal proceeding was initiated.

Applicant filed an Appeal Brief timely on December 3, 2008. The Examiner filed an Examiner's Answer on September 3, 2009. The Examiner's Answer withdrew grounds for rejecting Claims 6, 7, 15, and 16, and presented new grounds for rejecting these claims. This Reply Brief is filed in response to the Examiner's Answer.

The Claims Appendix attached reflects the currently pending claims as presented in the Amendment of June 12, 2008, prior to the Final Office Action.

Summary of the Claimed Subject Matter

37 C.F.R. § 41.37(c)(1)(v)

The subject matter of the patent application generally relates to aspects of an accessory mount device 10, shown in the example of FIGS. 2 and 4, that may be mounted to a control bracket 106 of a throttle control body, or a clutch control body, 104 on a handle bar 102 of a motor vehicle 100. The accessory mount 10 is affixed to the control body 104 so that an accessory 200 may be mounted to it. The accessory may include, for example, a GPS navigation device, music player, radar detector, etc.

For ease of explanation only, the following detailing of the subject matter of each independent claim, presented previously in the Appeal Brief, will refer to the examples shown in the drawing FIGURES of the application, with the understanding that the claims are not limited to the exemplary embodiments shown in these drawings.

Claim 1

The subject matter of independent Claim 1 relates to a vehicle accessory mount 10, shown in detail in the exemplary embodiment in FIGS. 4-6. The mount 10 is adapted for attachment to a control bracket 106 (FIG. 2) of a throttle or clutch control body 104 (FIG. 2) of a handle-barred vehicle 100. The vehicle accessory mount 10 has an accessory mount body 12 adapted for attachment to the control bracket 106 of the vehicle 100 via a pair of substantially parallel mounting holes 20, 22 that extend through the body 12. These mounting holes 20, 22 are aligned with portals 108, 114 in the control bracket 106. Further, a radial relief 35 is located between the parallel mounting holes 20, 22 of the accessory mount body 12. The accessory mount body 12 also has a threaded accessory hole 18 or 20. Thus, the accessory mount body 12 may be attached to the control bracket 106 via fasteners 40, 42 that extend through the mounting holes 20, 22 and control bracket portals 108, 114 to threadedly connect with the control body 104.

Claim 7

Claim 7 relates to a vehicle accessory mount 10 adapted for attachment to a control bracket 106 of a handle-barred vehicle throttle or clutch control body 104, as shown, for

example, in FIG. 2. The accessory mount 10 includes a body 12 adapted for attachment to the control bracket 106 and there is a pair of substantially parallel mounting holes 20, 22 extending through the body 12. The mounting holes 20, 22 are aligned with portals 108, 114 in the control bracket 106. A ball stud 30 or 34 is attached to the body 12. The body 12 is attachable to the control bracket 106 by location of fasteners 40, 42 through the mounting holes 20, 22 and control bracket portals 108, 114 in threaded connection with the control body 104.

Claim 8

Claim 8 relates to a vehicle accessory mount 10 adapted for attachment to a control bracket 104 of a handle-barred vehicle throttle or clutch control body 106, as shown, for example, in FIG. 2. The accessory mount 10 has a body 12 adapted for attachment to the control bracket 106. The body 12 has a pair of substantially parallel mounting holes 20, 22 extending through it. The mounting holes 20, 22 are aligned with portals 108, 114 in the control bracket 106. A pair of hollow standoffs 36, 38 is locatable between the mounting holes 20, 22 and bolt portals 108, 114 in the control bracket 106. The body 12 has a threaded accessory hole 28 or 32. The body 12 is attachable to the control bracket 106 by location of fasteners 40, 42 through the mounting holes 20, 22 and standoffs 36, 38, and control bracket portals 108, 114 in threaded connection with the control body 104, as seen in FIGS. 4 and 5, for example.

Claim 15

Claim 15 relates to a vehicle accessory mount 10 adapted for attachment to a control bracket 106 of a handle-barred vehicle throttle or clutch control body 104, as exemplified in FIG. 2. The accessory mount 10 has a body 12 adapted for attachment to the control bracket 106. The body 12 includes a pair of substantially parallel mounting holes 20, 22 extending through it. These mounting holes 20, 22 are aligned with portals 108, 114 in the control bracket 106. A pair of hollow standoffs 36, 38 is locatable between the mounting holes 20, 22 and the portals 108, 114. A ball stud 30 or 34 is attached to the body. The body 12 is attachable to the control bracket 106 by location of fasteners 40, 42 through the mounting holes 20, 22 and standoffs 36, 38, and control bracket portals 108, 114 in threaded connection with the control body 104.

Claim 19

Claim 19 relates to a vehicle accessory mount 10 adapted for attachment to a control bracket 104 of a handle-barred vehicle throttle or clutch control body 106, as exemplified in FIG. 2. The accessory mount 10 has a body 12 adapted for attachment to the control bracket 106. The body 12 has a threaded accessory hole 28 or 32 therein. Further, the body 12 has a pair of substantially parallel mounting holes 20, 22 extending through it. These mounting holes 20, 22 are aligned with portals 108, 114 in the control bracket 106. There is a pair of hollow standoffs 36, 38 locatable between the mounting holes 20, 22 and the bolt portals 108, 114 in the control bracket. The body 12 is attachable to the control bracket 104 by location of fasteners 40, 42 through the mounting holes 20, 22 and standoffs 36, 38, and control bracket portals 108, 114 in threaded connection with the control body 104.

Grounds of Rejection to be Reviewed on Reply in the Appeal

37 C.F.R. § 41.37(c)(1)(vi)

In the Appeal Brief, Applicant requested review of each of nine (9) grounds for final rejection of the pending claims. Of the original 9 grounds, the Examiner's Answer has now rendered grounds (5) and (9) moot by the withdrawal of these bases for claim rejection. Applicant hereby incorporates by reference, and reiterates, those grounds that are not mooted (i.e., grounds 1-4 and 6-8), but does not include them here for the sake of brevity. In addition, Applicant now addresses the two new grounds raised in the Examiner's Answer that presented new prior art, for the first time:

10. Whether Claims 6 and 7 are obvious under 35 USC § 103(a) due to Masui et al. in view of Koskinen (US Patent 3,568,968).

11. Whether Claims 15 and 16 are obvious under 35 USC § 103(a) due to Masui et al. and Japan Patent 4-133886 ("Komo") in view of Koskinen.

In addition, Applicant also presents replies responsive to arguments presented in the Examiner's Answer. These are included under three headings for the Board's consideration, as follows:

A. *The Meaning of the terms Control Body, Control Body Bracket, and Relation to Throttle and Clutch Control Bodies.*

- B. *Reply to the Examiner's Answer as to whether the preambles to the claims breathe life and meaning into each claim so that the preambles should be accorded full weight in assessing patentability over the cited prior art.*
- C. *The Primary Masui Reference*

Applicant also respectfully reiterates the request that the Board instruct the Examiner to permit an amendment to Claim 19, after resolution of the Appeal, to clarify and to avoid any potential antecedent basis issue. This issue was not raised in any Office Action. Claim 19 initially recites “portals” and further in the claim refers to “bolt portals.” Applicant seeks to delete the word “bolt” for purposes of clarity and to ensure proper antecedent basis.

Arguments in Reply
37 C.F.R. § 41.37(c)(1)(vii)

In this Reply Brief, Applicant will address the new bases for claim rejection raised in the Examiner's Answer. In addition, Applicant will reply to the Examiner's Answer regarding the preamble issue, numbered originally as issue 1. However, for the sake of brevity and because the Appeal Brief completely states Applicant's position on the other original issues, Applicant will not again present arguments in support of issues 1- 4 and 6-8, as originally numbered.

Applicant urges the Board to incorporate by reference the following explanations presented under headings A - C, about the meaning of terms, the preambles, and the primary reference, Masui, respectively, into the arguments presented on **all** the pending issues.

*A. The Meaning of the terms Control Body, Control Body Bracket,
and Relation to Throttle and Clutch Control Bodies.*

The claims recite the following preamble:

“An accessory mount adapted for attachment to a control bracket of a handle-barred vehicle throttle or clutch control body.”

The Examiner's Answer offers an interpretation of this preamble that may not be completely accurate. Applicant hereby parses the preamble in light of the knowledge of a person of skill in the

arts relating to handle-barred vehicles. Such a person would be aware that a vehicle with handle bars (“a handle-barred vehicle”) may have at least one “control body,” if it is a motorized vehicle. The control body may be one that relates to the vehicle’s throttle, which is a “throttle control body,” or it could be one that relates to the vehicle’s clutch, which is a “clutch control body.” Moreover, a person would know that either of such control bodies may have a “control bracket.” The accessory mount is adapted to mount to the control bracket – regardless of whether it is a control bracket of a throttle control body or the control bracket of a clutch control body.

The use of the term “adapted for” may not be structurally precise in the sense of limiting the structure to a specific structure of a certain configuration, but it does nonetheless limit the structures to those that are *compatible with and configured for attachment to a control bracket of a control body*. Accordingly, something that is adapted for attachment to a control bracket of a control body cannot be ignored summarily as “structure-less.” Further, it cannot be equated with an entirely dissimilar structure, like element 34 of Masui, which is adapted to mount directly to a handle-bar stem of a bicycle, and NOT to be attached to a control bracket of a control body. These reflect different adaptations, and hence different structures.

B. Reply to the Examiner’s Answer as to whether the preambles to the claims breathe life and meaning into each claim so that the preambles should be accorded full weight in assessing patentability over the cited prior art.

Applicant hereby responds to the Examiner’s Answer with respect to the preamble issue. Applicant submits that the case law supports the proposition that, in this instance, the preambles breathe life and meaning into the claims so that the preambles should be accorded full weight in assessing patentability.

The Examiner’s Answer completely overlooks that the body of the claim *in each instance* refers back to the preamble for antecedent basis and is thus “reflected in the body of the claim.” According to the case law, when such is the case, then the preamble cannot be dismissed as a “mere statement of intended use.” Indeed, the Examiner’s Answer fails to address this important antecedent basis issue at all. Applicant’s position is fully supported in the case law cited and explained in the Appeal Brief. Applicant had explained as follows:

Applicant submits that in the instant claims, the case law supports this interpretation. For example, in an interference proceeding, this Board ruled that the preamble to a claim (or count) should be given weight in construing the claim. The (losing) junior party appealed to the federal court. In *Griffin v. Bertina*, 285 F.3d 1029; 2002, U.S. App. LEXIS 5644; 62 U.S.P.Q.2d (BNA) 1431 (Fed. Cir. 2002), the court affirmed the ruling of this Board. The *Griffin* court held that “the Board did not err in construing the count to be limited by the preamble.” In arriving at its holding, *Griffin* noted, in particular, that the preamble language was directed to “diagnosing an increased risk for thrombosis of a genetic defect causing thrombosis,” (emphasis added) and that this “[diagnosing] aspect of the invention is again stated in the body of the count.” Accordingly, *Griffin* teaches that when an aspect of the claimed invention that is recited in the preamble is also reflected in the body of the claim, then the preamble “gives life and meaning” to the claimed invention so that the preamble is entitled to full weight in assessing patentability. *Griffin* also cited long-standing and well-known precedent, including *Kropa v. Robie*, 38 C.C.P.A. 858, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951) (stating that a preamble is limiting when it is “necessary to give life, meaning and vitality to the claims or counts”) before arriving at its holding that the preamble gives life and meaning to the claim and should be given weight. (Emphasis added)

... in *Boehringer Ingelheim Vet Medica Inc. v Schering Plough Corp. et al.*, 20 F.3d 1339; 2003 U.S. App. LEXIS 3232; 65 U.S.P.Q.2D (BNA) 1961 (Fed Cir 2003), the Court held that: “[A] preamble simply stating the intended use or purpose of the invention will usually not limit the scope of the patent claim, unless the preamble provides antecedents for ensuing claim terms and limits the claim accordingly (emphasis added). Thus, *Boehringer* teaches that where the preamble provides antecedent basis for features recited in the body of a claim, the preamble should be accorded full weight in interpreting the claim. (Emphasis added)

Furthermore, the Examiner’s Answer fails to address the “wherein clauses” of claims. *Griffin* also affirmed the Board’s ruling giving limiting effect to the wherein clauses at issue. Again, *Griffin* reasoned that “wherein clauses” should be limiting when they “relate back to and clarify what is required by the count.” In particular, as to one of the “wherein clauses,” *Griffin* noted that it “elaborates the meaning of the preamble, by indicating that the point mutation correlates with a decrease in the degree of inactivation of human Factor V and/or human Factor Va by APC (*i.e.*, increased APC resistance), and hence an increased risk of thrombosis.” Thus, a wherein clause may elaborate the preamble and thereby make the preamble a “living and breathing” part of the claimed subject matter.

Applicant submits that *Griffin* and *Boehringer* are both applicable in the instant application for the following reasons:

1) As in *Griffin*, the body of each claim “reflects language of the preamble” or, put another way, the preamble provides antecedent basis for the body. For example, Claims 1, 7, 8, 15, and 19 (and their respective dependent claims) recite “wherein the body is attachable to the control bracket,” and the preamble recites “[A] vehicle accessory mount adapted for attachment to ‘a control bracket’ of a handle-barred vehicle throttle or clutch control body.” Accordingly, as in *Griffin*, where the “diagnosing” language in the preamble that was also reflected in the body of the claim was determinative, here the “control bracket” language from the body of the claim reflects an aspect of the preamble which also recites a “control bracket.” Furthermore, the “**the** control bracket” language in the body of the claim also relies on the preamble for antecedent basis, as in *Boehringer*. This provides a first basis for giving weight to the preamble in assessing patentability of the claimed subject matter.

2) While in *Griffin* the body of the claims only reflected one feature (“diagnosing”) of the preamble, here at least two features are so reflected and the case is even more compelling to give weight to the preamble. Aside from the “control bracket” discussed above, each claim body also reflects “control body” language of the preamble. For example, each independent claim (and therefore their respective dependent claims) recites “wherein . . . control bracket portals in threaded connection with the control body,” and the preamble recites “[A] vehicle accessory mount adapted for attachment to a control bracket of a handle-barred vehicle throttle or clutch control body.” Accordingly, as in *Griffin*, where the “diagnosing” language in the preamble that was also reflected in the body of the claim was determinative, here the “control body” language from the body of the claim (the wherein clause) reflects an aspect of the preamble which also recites a “control body.” Furthermore, the “**the** control body” language in the body of the claim also relies on the preamble for antecedent basis. This provides a second basis for giving weight to the preamble in assessing patentability of the claimed subject matter.

3) As in *Griffin*, the preamble provides a context without which the claim body is meaningless. Without the “control bracket” and “control body” language in the preamble that provides the context of a “handle-barred vehicle,” the “control bracket” and “control body” language in the body of the claim may be meaningless. To paraphrase the *Griffin* query, “What is

the control body, what is the control bracket, and how are they related to each other?" The answer is provided in the preamble which states that the control bracket relates to the control body of a clutch or throttle controller of a handle-barred vehicle. This provides a third basis for giving weight to the preamble in construing the claimed subject matter.

4) As in *Boehringer*, the preamble in each pending claim provides antecedent basis for a term used in the body of the claim. For example, each claim recites "wherein the body is attachable to the control bracket," and the preamble recites "[A] vehicle accessory mount adapted for attachment to a control bracket of a handle-barred vehicle throttle or clutch control body." Accordingly, as in *Boehringer*, the preamble provides antecedent basis for the language, "the control body," in the body of the claim. This provides another basis for giving weight to the preamble in assessing patentability of the claimed subject matter.

Applicant points out that the Examiner's Answer made no rejection based on improper antecedent basis with respect to any of the claims' referring back to and reliance on elements of the preamble for antecedent basis. Accordingly, the Examiner's Answer accepted that such referring back for antecedent basis was proper. Indeed, the body of each of the claims depends upon the preamble for completeness and for antecedent basis to comply with 35 USC § 112. For example, Claim 1 (and its dependent claims) recites "wherein the body is attachable to the control bracket," and the preamble recites "[A] vehicle accessory mount adapted for attachment to a control bracket of a handle-barred vehicle..." Accordingly, the preamble provides antecedent basis for the "the control bracket" language in the body of the claim. The claim, therefore, depends upon the preamble in order to meet the antecedent basis requirement of 35 USC § 112. According to *Boehringer*, this is *in itself* sufficient to rule that the preamble should be accorded full weight. The Examiner's Answer avoids this issue; if there was no objection based on improper antecedent basis, then antecedent basis is proper based on the preambles. *If a patent claim body recites an element that relies for antecedent basis an element of the preamble, the preamble cannot be dismissed as a "mere statement of intended use" but must be accepted as part of the claim.* 35 USC § 112 dictates that if, as in this case, the preamble is relied upon to meet the antecedent basis requirement, then it cannot be ignored in assessing patentability.

Applicant respectfully requests a ruling from the Board that the preambles of all pending claims breathe life and meaning into the claims and should be given full weight in assessing

patentability. Further, that the subject matter of all pending claims are patentable over the cited art when the preambles of the claims are taken into consideration, as required by law.

C. The Primary Masui Reference

The primary reference in all grounds for the rejection of claims is Masui. This reference relates to bicycles that are not motorized. The described technology is for mounting a display to a bicycle handle bar. Bicycles, not being motorized, have no throttle control bodies, or clutch control bodies, as may be found on motorized, handle-barred vehicles, such as motor bikes and off road three- and four-wheeled, handle-barred vehicles. Accordingly, the Masui device has neither a bracket of a clutch control body nor a bracket of a throttle control body. The structure that the Examiner relies on to show control bodies, or control body brackets, is clearly described in Masui as “stem arch mounting sections.” This will be explained with reference to FIG. 3 of Masui (below), and Masui’s description at column 4, lines 40 through 65:

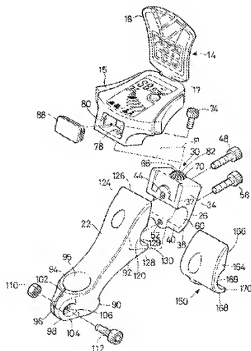


FIG. 3

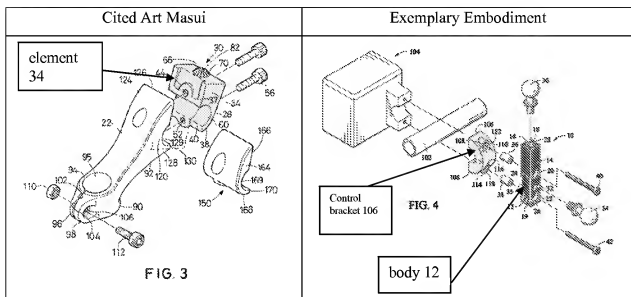
Second end 92 of handlebar stem 22 includes a stem arch 120, a first stem arch mounting section 124 disposed at a first end of stem arch 120, and a second stem arch mounting section 128 disposed at a second end of stem arch 120. A semicircular or other-shaped concave inner peripheral surface 129 is formed between first stem arch mounting section 124 and second stem arch mounting section 128. First stem arch mounting section 124 has a first stem arch surface 126 that faces first mounting surface 37 of mounting arch 26, and second stem arch mounting section 128 has a second stem arch surface 130 that faces second mounting surface 40 of mounting arch 26. A first threaded blind hole (not shown) intersecting first stem arch surface 126 is disposed in first stem arch mounting section 124 so as to align with first mounting opening 44 in mounting arch 26, and a second threaded blind hole (not shown) intersecting second stem arch surface 130 is disposed in second stem arch mounting section 128 so as to align with second mounting opening 52 in mounting arch 26. As a result, mounting arch 26 (and display 14) may be fastened to stem arch 120 by passing bolts 48 and 56 through first mounting opening 44 and second mounting opening 52, respectively, and screwing them into their respective threaded blind holes in first stem arch mounting section 124 and second stem arch mounting section 128.

From the description reproduced above, it becomes apparent that the Examiner's "control body" or "control body bracket," which he lists as any of elements 124, 126, 128, and 130, are "stem arch mounting sections" and "stem arch surfaces." As explained above, a "control body" is understood by a person who has knowledge about handle-barred, motorized vehicles as either a reference to the throttle control body, or as a reference to the clutch control body. It is not a term that "lacks structure" or that lacks any common meaning, as the Examiner seems to assert. A control body and a bracket of a control body is not a stem arch, or a surface of a stem arch, of a bicycle. Moreover, the control body and control bracket are *structurally different* from the stem arch and the stem arch surfaces.

The structural differences may be more clearly apparent from a comparison of FIGS. 3 and 11 of Masui and an exemplary embodiment of the present application, shown in FIG. 4 (reproduced here below). Referring to Masui, which relates to a bicycle, not a motorized, handle-barred vehicle, element 34 is not "a body 12 adapted for attachment to the control bracket 106" (numerals refer to FIG. 4 of the application), as recited in Claim 1, for example. Instead, element 34 of Masui is described as a "first mounting section 34," and it attaches directly to one side of the bicycle handle bar stem as shown in FIG. 11. A pair of bolts 48 and 56 extends through the body of element 34 to thread into element 50 so that elements 34 and 50 are securely bolted to the outside of the handle

bar stem 18. Thus, element 34, unlike exemplary body 12 of the claimed subject matter, is NOT adapted for attachment to a control bracket, as recited in Claim 1, for example.

The claimed body of the accessory mount is adapted for attachment to a control bracket of a control body on a handle-barred vehicle, as recited in the preambles of the claims, which should be accorded weight as explained elsewhere herein. It is not adapted for direct mounting to the handle bar stem itself, in sharp contrast to element 34 of Masui which is specifically adapted to attach directly to the handle bar stem itself, as is very clear from the drawings reproduced below:



As can be seen from the above side-by-side comparison, exemplary control bracket 106 of FIG. 4 of the present application is configured (or “adapted”) to partially surround a handle bar 102. Control bracket 106 may be mounted to the control body 104 with the handle bar 102 between them. The FIG. 4 example of the claimed accessory mount 10 has a body 12 that mounts to a rear side of control bracket 106 which in turn mounts to a control body 104 with a pair of bolts 40, 42. *In sharp contrast, element 34 of Masui does not mount to a control bracket of a control body but rather mounts directly to a handle bar stem.* Indeed, as detailed above, Masui fails to show a control body or its associated control bracket because it relates to a *bicycle*. The Examiner’s Answer asserts that elements 124, 126, 128, and 130 are each “control brackets.” These features are, however, called out as “stem arch sections” in Masui at column 4, lines 40 through 65. There

are simply no control bodies nor associated brackets of a control body in Masui. And, one would NOT expect to find either in Masui, because it relates to a bicycle, not to a motorized, handle-barred vehicle. Thus, it requires neither (1) a control body (e.g. throttle control body or clutch control body), nor (2) any brackets associated with it. Not having either, and not needing either, Masui can neither teach nor suggest control bodies nor control brackets. Accordingly, Applicant submits that there are substantial differences between the primary Masui cited art and the claimed subject matter, *both structurally and functionally*.

10. Whether Claims 6 and 7 are obvious under 35 USC § 103(a) due to Masui et al. in view of Koskinen.

Claim 6 depends from Claim 1, and should be interpreted, as explained above, to include the preamble of Claim 1. The “body” recited in both claims is adapted for attachment to a control bracket of a throttle or clutch control body of a handle-barred vehicle. Claim 6 includes a ball stud threaded to an accessory hole. Claim 7 is independent and has an accessory mount that includes a ball stud attached to the mount body.

While the new grounds for rejection include a combination of two references, *Graham v John Deere* teaches that the focus should be on the *differences between the cited art and the claimed invention as a whole*. To ascertain these differences, it is instructive to look for differences between the primary reference (Masui) and the claimed invention (or an embodiment thereof) and to determine whether the secondary reference (Koskinen) provides any deficiency in teaching or suggestion of the primary reference. Thus, for ease of explanation, Applicant will first compare Masui with the claimed subject matter using as a guide an exemplary embodiment, on the understanding that the scope of the claimed subject matter is not limited to these drawings of exemplary embodiments.

Compare FIGS. 3 and 11 of Masui and an exemplary embodiment of the present application, shown in FIG. 4. Referring to Masui, which relates to a bicycle, not a motorized handle-barred vehicle, element 34 is not “a body 12 adapted for attachment to the control bracket 106” (numerals refer to FIG. 4 of the application), as recited in Claims 6 and 7 of the present application (both of which include the language of Claim 1). Instead, element 34 of Masui is described as a “first mounting section 34,” and it attaches directly to one side of the bicycle handle

bar stem as shown in FIG. 11 of Masui. A pair of bolts 48 and 56 extends through the body of element 34 to thread into element 50 so that elements 34 and 50 are securely bolted directly to the outside of the handle bar stem 18. Thus, element 34, unlike exemplary body 12 of the claimed subject matter, is NOT adapted for attachment to a control bracket, as recited in Claims 6 and 7, but to the handle bar stem directly.

The claimed body of the accessory mount is adapted for attachment to a control bracket of a control body on a handle-barred vehicle, as recited in the preamble of Claims 6 and 7 (based on Claim 1), which should be accorded weight as explained above. It is not adapted for direct mounting to the handle bar stem itself, in sharp contrast to element 34 of Masui which is adapted for direct mounting to a handle bar stem.

Koskinen is cited only for showing the “ball stud attached to the threaded accessory hole” recited in the subject matter of Claims 6 and 7. However, Koskinen is not cited for, and does not show, teach or suggest the control bracket or the control body. Indeed, Koskinen relates to an umbrella stand, with an umbrella post 20 resting in a locking sleeve 22 with a lower end threaded to a ball housing sleeve 24. A ball 30 in the ball joint 26 is secured to the top of a threaded rod 32 which is in turn engaged with a mounting plate 34 bolted to a surface 36. The post and umbrella may be pivoted and locked into position using a locking sleeve 22 to force the ball against ball joint 26. Koskinen is devoid of any teaching regarding motorized, handle-barred vehicles, or control bodies, or the securing of accessories to control bodies, or to any brackets of the control bodies. Accordingly, Koskinen fails to teach features of the claimed subject matter that are not found in Masui, and the combination fails to teach or suggest the claimed subject matter.

Koskinen does not teach or suggest a ball stud that is *attached* to a threaded accessory hole of the body, as in Claim 6, or even one that is attached to the body (whether to a threaded accessory hole or not) as in Claim 7. Instead, the Koskinen ball 30 is received within a ball joint where it is free to rotate, as is characteristic of a ball joint, and not threaded in place. The ball 30 is not “attached” to the (threaded) ball joint structure around it, but is held in place and able to rotate easily. When the umbrella post 20 is threaded downwards into the ball housing sleeve 24, it ultimately urges against ball 30 and by friction prevents it from rotation. Again, post 20 is not “attached” to the ball 30, but rather it is urged tightly against it. Koskinen does not anywhere

depict a ball stud that is *attached* to another structure either mechanically, as by a bolt threaded into the ball, for example, or by an adhesive means, or by any other means.

Koskinen, like Masui, does not show a body that is “adapted for attachment to the control bracket” of a throttle or clutch control body of a handle-barred vehicle. Thus, Koskinen does not supply the deficiencies of Masui. Accordingly, the combination of Masui with Koskinen cannot render Claims 6 or 7 obvious. Applicant therefore respectfully requests that the Board find Claims 6 and 7 patentable over the cited art.

Applicant also notes that neither Masui nor Koskinen relate to motorized, handle-barred vehicles, and the citation of Koskinen is in particular questionable as being in a totally unrelated field of art. The combination reflects the prohibited use of hindsight in picking and choosing between isolated sections of references to unfairly denigrate subject matter that is, in all fairness, non-obvious.

11. Whether Claims 15 and 16 are obvious under 35 USC § 103(a) due to Masui et al. and Japan Patent 4-133886 in view of Koskinen.

Claim 15 is independent and Claim 16 depends from Claim 15. Each claim should be interpreted, as explained above, to include the preamble of Claim 15. Thus, Claims 15 and 16 each include a body that is “adapted for attachment to the control bracket” of a throttle or clutch control body of a handle-barred vehicle. This feature is not found in the primary Masui reference because the element 34 fails to meet the requirements of the recited “body,” as explained in more detail above, with reference to Claims 6 and 7, and incorporated here by reference for brevity.

As to Claim 15, Japan Patent 4-133886 is cited solely for showing a pair of hollow standoff's located between the mounting holes and portals, and Koskinen solely for showing a ball stud attached via a threaded hole.

Koskinen is cited only for showing the “ball stud” recited in the claimed subject matter. However, Koskinen is not cited for, and does not show, teach or suggest the control bracket or the control body. Indeed, Koskinen relates to an umbrella stand, with an umbrella post 20 resting in a locking sleeve 22 with a lower end threaded to a ball housing sleeve 24. A ball 30 in the ball joint 26 is secured to the top of a threaded rod 32 which is in turn engaged with a

mounting plate 34 bolted to a surface 36. The post and umbrella may be pivoted and locked into position using a locking sleeve 22 to force the ball against ball joint 26. Koskinen is devoid of any teaching regarding motorized handle-barred vehicles, and the securing of accessories to control bodies and/or brackets of the control bodies.

Koskinen does not teach or suggest a ball stud *attached* to the body, as in Claims 15 and 16. The ball 30 is received within a ball joint where it is free to rotate, as is characteristic of a ball joint. Thus, the ball 30 is not “attached” to the ball joint structure around it, but is held in place within a cavity and able to rotate easily within the cavity. When the umbrella post 20 is threaded downwards into the ball housing sleeve 24, it ultimately urges against ball 30 and by frictional force prevents it from rotation. Again, the post 20 is not “attached” to the ball 30, but rather it is urged tightly against it. Koskinen does not anywhere depict a ball stud that is attached to another structure either mechanically, as by a bolt threaded into the ball, for example, or by an adhesive means, or by any other means.

Koskinen also does not teach or suggest a ball stud in threaded connection to an accessory hole of a body, as in Claim 16. Instead, the Koskinen ball 30 is received within a ball joint where it is free to rotate, as is characteristic of a ball joint. Ball 30 is not in threaded connection to anything at all. When the umbrella post 20 is threaded downwards into the ball housing sleeve 24, it ultimately urges against ball 30 and by friction prevents it from rotation. Again, post 20 is not “attached” to the ball 30, but rather it is urged tightly against it. Koskinen does not anywhere depict a ball stud that is in *threaded connection* to another structure.

Koskinen, like Masui, does not show a body that is “adapted for attachment to the control bracket” of a throttle control body or a clutch control body of a handle-barred vehicle. Thus, Koskinen does not supply the deficiencies of Masui. Accordingly, the combination of Masui with Koskinen cannot render Claims 15 or 16 obvious. Applicant therefore respectfully requests that the Board find Claims 15 and 16 patentable over the cited art.

Applicant reiterates that neither Masui nor Koskinen relate to motorized handle-barred vehicles, and the citation of Koskinen is in particular questionable as being in a totally unrelated field of art. The combination reflects the prohibited use of hindsight in picking and choosing between isolated sections of references to unfairly denigrate subject matter that is, in all fairness, non-obvious.

Secondary Considerations

The previously-submitted Declaration of Ted A. Barnes shows indicia of non-obviousness; namely, (1) copying by another and (2) commercial success. The Examiner's Answer seems to confuse copying with commercial success and conflates sales growth and copying. Sales growth in itself speaks to commercial success, and this is set forth in the Declaration. The copying by others, also set forth in the Declaration, speaks to non-obviousness, in that the copyists are motivated by demand for the product in the market place and by the resultant potential for profit. Further, copying also reflects a lack of viable non-infringing alternatives, which also speaks to non-obviousness.

CONCLUSION

Applicant respectfully submits that the explanations and applicable case law provided support a finding by the Board that all claims now pending are allowable over the cited art. In addition, a minor amendment to Claim 19 should remove any objection based in lack of clarity or antecedent basis. For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully requests full allowance of Claims 1 - 19.

Applicant does not believe that any fees are due; however, in the event that any fees are due, the Commissioner is hereby authorized to charge any required fees due (other than issue fees), and to credit any overpayment made, in connection with the filing of this paper to Deposit Account 50-2180 of Storm LLP.

Respectfully submitted,

Dated: November 3, 2009
Storm LLP
901 Main Street
Suite 7100
Dallas, Texas 75202
Telephone: (214) 347-4703
Fax: (214) 347-4799

_____/John G. Fischer/
John G. Fischer
Reg. No. 41,748

Claims Appendix
37 C.F.R. § 41.37(c)(1)(viii)

1. A vehicle accessory mount adapted for attachment to a control bracket of a handle-barred vehicle throttle or clutch control body, comprising:
a body adapted for attachment to the control bracket;
a pair of substantially parallel mounting holes extending through the body;
the mounting holes aligned with portals in the control bracket;
a radial relief located between the parallel mounting holes;
a threaded accessory hole in the body; and,
wherein the body is attachable to the control bracket by location of fasteners through the mounting holes and control bracket portals in threaded connection with the control body.
2. The vehicle accessory mount of Claim 1, each mounting hole further comprising:
a cylinder portion; and,
a countersink portion that is larger in diameter than the cylinder portion.
3. The vehicle accessory mount of Claim 1, further comprising:
wherein the body is generally rectangular.
4. The vehicle accessory mount of Claim 1, further comprising:
wherein the threaded accessory hole is located between the mounting holes.
5. The vehicle accessory mount of Claim 1, further comprising:
wherein the threaded accessory hole is located in substantially perpendicular relationship to the mounting holes.
6. The vehicle accessory mount of Claim 1, further comprising:
a ball stud attached to the threaded accessory hole.

7. A vehicle accessory mount adapted for attachment to a control bracket of a handle-barred vehicle throttle or clutch control body, comprising:
 - a body adapted for attachment to the control bracket;
 - a pair of substantially parallel mounting holes extending through the body;
 - the mounting holes aligned with portals in the control bracket;
 - a ball stud attached to the body; and,wherein the body is attachable to the control bracket by location of fasteners through the mounting holes and control bracket portals in threaded connection with the control body.
8. A vehicle accessory mount adapted for attachment to a control bracket of a handle-barred vehicle throttle or clutch control body, comprising:
 - a body adapted for attachment to the control bracket;
 - a pair of substantially parallel mounting holes extending through the body;
 - the mounting holes aligned with portals in the control bracket;
 - a pair of hollow standoffs locatable between the mounting holes and bolt portals in the control bracket;
 - a threaded accessory hole in the body; and,wherein the body is attachable to the control bracket by location of fasteners through the mounting holes and standoffs and control bracket portals in threaded connection with the control body.
9. The vehicle accessory mount of Claim 8, further comprising:
 - wherein the body is generally rectangular.
10. The vehicle accessory mount of Claim 8, the body further comprising:
 - a radial relief located between the parallel mounting holes.
11. The vehicle accessory mount of Claim 8, further comprising:
 - wherein the threaded accessory hole is located between the mounting holes.

12. The vehicle accessory mount of Claim 8, further comprising:
wherein the threaded accessory hole is located in substantially perpendicular relationship to the mounting holes.
13. The vehicle accessory mount of Claim 8, each mounting hole further comprising:
a cylinder portion; and,
a countersink portion that is larger in diameter than the cylinder portion.
14. The vehicle accessory mount of Claim 8, further comprising:
wherein the inside diameter of each hollow standoff is substantially the same as the inside diameter of the cylinder portion of the mounting holes.
15. A vehicle accessory mount adapted for attachment to a control bracket of a handle-barred vehicle throttle or clutch control body, comprising:
a body adapted for attachment to the control bracket;
a pair of substantially parallel mounting holes extending through the body;
the mounting holes aligned with portals in the control bracket;
a pair of hollow standoffs locatable between the mounting holes and the portals;
a ball stud attached to the body; and,
wherein the body is attachable to the control bracket by location of fasteners through the mounting holes and standoffs and control bracket portals in threaded connection with the control body.
16. The vehicle accessory mount of Claim 8, further comprising:
wherein the threaded accessory hole in the body is receivable of one of an accessory and a ball stud in threaded connection.
17. The vehicle accessory mount of Claim 8, further comprising:
wherein each standoff is locatable in a recess on the control bracket.

18. The vehicle accessory mount of Claim 8, further comprising:
wherein each standoff is locatable in a countersunk portion on the control bracket.
19. A vehicle accessory mount adapted for attachment to a control bracket of a handle-barred vehicle throttle or clutch control body, comprising:
a body adapted for attachment to the control bracket;
a threaded accessory hole in the body;
a pair of substantially parallel mounting holes extending through the body;
the mounting holes aligned with portals in the control bracket;
a pair of hollow standoffs locatable between the mounting holes and bolt portals in the control bracket; and,
wherein the body is attachable to the control bracket by location of fasteners through the mounting holes and standoffs and control bracket portals in threaded connection with the control body.

Evidence Appendix
37 C.F.R. § 41.37(c)(1)(ix)

No additional secondary evidence.

Related Proceedings Appendix
37 C.F.R. § 41.37(c)(1)(x)

No related decisions rendered by a court or the Board of Patent Appeals and Interferences.